



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/022,649 | 12/17/2001 | Francis D. Palazzo | 4665/5 | 1815 |

56015 7590 10/17/2005

MOSER, PATTERSON & SHERIDAN, LLP/
SEDNA PATENT SERVICES, LLC
595 SHREWSBURY AVENUE
SUITE 100
SHREWSBURY, NJ 07702

EXAMINER

SALCE, JASON P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2614

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/022,649 | PALAZZO ET AL. | |
| | Examiner | Art Unit | |
| | Jason P. Salce | 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8-12,14 and 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-12,14 and 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Be

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/1/2005 has been entered.

Response to Arguments

Applicant's arguments filed 8/1/2005 have been fully considered but they are not persuasive. The claims still read on the Fries reference of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 5, 7-9, 11-12 and 14-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fries (U.S. Patent No. 6,317,885).

Referring to claim 1, Fries discloses providing access to EPG features from within broadcast advertisements (see Figure 6 for accessing program listings (one broadcast advertisement) from within broadcast advertisements (the page options presented in Figure 6)).

Fries also discloses storing presentation guide software for presenting an EPG at a user location (see Column 6, Lines 37-40).

Fries also discloses receiving the broadcast advertisement comprising audio, video and promotional metadata over a broadcast distribution network (see Column 3, Lines 24-28 for receiving audio and video over a broadcast distribution network, Column 3, Lines 66-67 and Column 4, Lines 1-3 for providing information pages (metadata), and Column 6, Lines 52-55 to teach that the information pages can be sent from advertisers, therefore teaching that the metadata is promotional metadata), the promotional metadata including a plurality of data items (see Figure 6 for the promotional page (containing advertisements) consisting of a plurality of data items), the data items including a promotion type ("Market Report" option in Figure 6 or the page accessed in Figure 8) and an EPG feature ("Television Listings" option in Figure 6), the promotion type including a purchasable event (see "Purchase Now" option in Figure 8) and an interactive advertisement (see "Selection Chart" option in Figure 8).

Fries also discloses displaying the EPG (see Figure 6 and note that since the page of options in Figure 6 contains an option for television listings, Figure 6 is itself an EPG containing broadcast advertisements (all the other options)).

Fries also discloses presenting a broadcast advertisement based on the data items (see Figure 6 for displaying broadcast advertisements available for selection), the broadcast advertisement including the EPG feature (again note that the broadcast advertisements in Figure 6 contain the broadcast advertisement for selecting television listings and therefore a broadcast advertisement in the list of broadcast advertisements includes an EPG feature).

Fries also disclose executing the EPG feature when it is selected from within the broadcast advertisement by a user (see Column 7, Lines 17-21).

Fries also discloses that the EPG feature accesses on-online content (see Column 4, Lines 1-16).

Referring to claim 3, Fries discloses receiving the promotional metadata as data encoded into a private data packet transmitted over the broadcast distribution network (Column 5, Lines 37-50 and Lines 59-67 for decoding packets according to there PID). Also note Column 22, Lines 61-67 and Column 23, Lines 1-15 for a description of the private message data contained within the metadata transmitted to a user. Since the metadata contained in a packet has it's own PID for identification at the receiver end, it is inherent that this packet be a private data packet, since it is separate from the audio and video packets.

Referring to claim 8, Fries discloses recording the broadcast advertisement (see the Table at Column 18 for a discloser of a RECORD command). The examiner notes that a time can be set for the record command, therefore it is inherent that a commercial or an infomercial can be set for recording, which are both promotional advertisements.

Referring to claim 9, Fries discloses a local recording device (see VCR at Column 6, Lines 27-28).

Referring to claim 11, Fries discloses a full-screen advertisement (see Figure 8).

Referring to claim 12, Fries discloses presenting the broadcast advertisement within an electronic program guide (see Figure 6 and the rejection of claim 1 for a description of the EPG being accessed from a broadcast advertisement to access the EPG).

Referring to claims 14-15, see rejection of claim 1. Note that the electronic program guide in Figure 8 displays an advertisement for ordering merchandise.

Referring to claim 16, see the rejection of claim 1 and further note that Fries discloses collecting payment information, if the promotion type is the purchasable event (see Column 13, Line 55 through Column 14, Line 57 and Figure 7). Note Column 14, Line 48 for collecting a payment method/information.

Referring to claim 17, see the rejection of claim 11.

Referring to claim 18, Fries discloses that a plurality of promotions is interspersed among the broadcast audio and video content (see Column 5, Lines 37-50 and Lines 60-67 for extracting audio, video and data packets interspersed within a 6 megahertz television channel, according to their PIDs).

Referring to claim 19, Fries discloses presenting the promotion within an EPG, when the promotion type is the interactive advertisement (see Figures 6 and 8 for presenting a promotion "MARKET REPORT" within an EPG 108, where the promotion is the interactive advertisement).

Referring to claim 20, Fries discloses that the data items include a web action (see anchor focus area action in the table under Column 8) and a web address (see Column 22, Line 67 through Column 23, Line 3 for the data containing information for linking to another page).

Fries also discloses receiving a selection of the web action and providing access to a web page associated with the web address (see Figure 6 and Column 6, Line 66 through Column 7, Line 53 for displaying a menu web page and selecting a link from the page and accessing other web pages from the current page).

Referring to claim 24, Fries discloses storing a plurality of promotions (see browser 62 in Figure 3 and Column 6, Lines 35-42).

Fries also discloses presenting the stored promotions (see Figure 6).

Referring to claim 25, Fries discloses that the data items are selected from an EPG action (see Figure 6 and Column 7, Lines 40-47 for the ESPN pages containing EPG actions).

Referring to claim 26, Fries discloses that the EPG action is selected from a pay-per-view purchase (see Column 13, Lines 47-64).

Referring to claim 27, see the rejection of claim 1 and note that Fries further teaches a plurality of navigation tools (see the table in Column 10-12), a display interface to present the presentation and navigation tools on a display device (see Figures 6 and 8) and wherein the navigation tools provide interaction with the EPG action within the promotion (see Figures 6 and 8).

Referring to claims 28-32, see the rejection of claims 17-19 and 25-26, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885).

Referring to claim 2, Fries teaches all of the limitations in claim 1, but fails to teach transmitting the promotional metadata in the VBI of the video signal. The examiner takes Official Notice that it is well known to use the VBI to transmit numerous types of metadata. It would have been obvious to include the promotional metadata in the VBI for the purpose of simultaneously transmitting promotional data at the same time audio and video data relating to the promotional metadata are transmitted to a user.

Referring to claim 10, Fries teaches all of the limitations in claim 8, but fails to teach that the promotional advertisement is recorded to a local recording device. The examiner takes Official Notice that it is well known to recording advertising on a local recording device, such as a memory. It would have been obvious to use a VCR or TIVO to record the promotional advertisement for the purpose of allowing a user to

Art Unit: 2614

watch a promotional advertisement (or other video program) at a more convenient time for the user.

Referring to claim 21, Fries discloses displaying a web page on a television, but fails to teach displaying a web page in a PIP window. The examiner takes Official Notice that it is well known to display web pages in PIP windows. It would have been obvious to a person of ordinary skill in the art to modify the display, as taught by Fries, using a PIP, for the purpose of minimizing obstruction of television programming viewed by a subscriber.

4. Claims 4, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885) in view of the TV Anytime as an application scenario for MPEG-7 article by Pfeiffer and Srinivasan.

Referring to claim 4, Fries discloses all of the limitations in claims 1, but fails to teach parsing the metadata into a set of individual data elements. The article entitled "TV Anytime as an application scenario for MPEG-7" by Pfeiffer and Srinivasan teaches an XML schema processor for parsing metadata for presentation of this data on an EPG (see Page 90, first column, last paragraph and Page 90, second column second paragraph). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the set-top box in Figure 3, as taught by Fries, by including the XML schema processor, as taught by Pfeiffer and Srinivasan, for the purpose of adding value-added interactive services, that allows end users to

personalize and control the material of interest (see Page 89, column 1, second paragraph of Pfeiffer and Srinivasan).

Claim 6 directly relates to claim 4 by including the XML schema processor of Pfeiffer and Srinivasan in the set-top box of Fries. The examiner notes that this processor will provide the set-top box of Fries with the ability to process metadata in the form of XML for the same purpose and motivation as shown in the rejection of claim 4.

Referring to claim 13, Fries teaches all of the limitations of claim 13 in the rejection of claim 1, with the exception of parsing the promotional metadata to determine the one or more valid electronic program guide features that are available. The examiner notes that Pfeiffer and Srinivasan teach this limitation and motivation for combining in the rejection of claim 4.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885) in view of Lawler et al. (U.S. Patent No. 5,699,107) in further view of Matthews.

Referring to claim 22, Fries discloses displaying data items on a television display (see Figures 6 and 8), but fails to teach the additional limitations in the claim.

Lawler discloses a displaying data items on a television display, the data items including a show date, show time and tune action (see Figure 3 and note that the tune action is the channel number the viewer must tune to or the cell that can be selected by the user).

Lawler also discloses determining whether the promotion is for an event that is presently playing using the data items (see step 224 in Figure 4A), the data items including a show date and show time (see Figure 3).

Lawler also discloses setting a reminder, when a program reminder is selected and the event is not presently playing (see step 236 in Figure 4A and step 314 in Figure 7 and Figure 8).

Lawler also discloses tuning the event, when the event is presently playing (see Column 10, Lines 10-14).

At the time the invention was made, it would have been obvious to modify the system of Fries, using the reminder system of Lawler, for the purpose of allowing a user to quickly and easily find and select desired future programs for reminding (see Column 2, Lines 8-10 of Lawler).

Fries and Lawler fail to disclose tuning the event, when the event is presently playing and the program reminder is not selected (thereby implying that the channel is automatically tuned to after the reminder is displayed).

Matthews discloses setting a reminder and automatically tuning to the channel after the reminder has been displayed (see Column 12, Lines 31-36).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reminder system of Fries and Lawler, using the automatic tuning reminder system, as taught by Matthews, for the purpose of providing a better way of integrating supplemental content, be it on the Internet or elsewhere, with conventional TV and movie programs (see Column 4, Lines 22-24 of Matthews).

Claim 23 corresponds to claim 22, Lawler further discloses setting a recording device, when the event is not presently playing and the program reminder is not selected (see Figure 10).

Conclusion

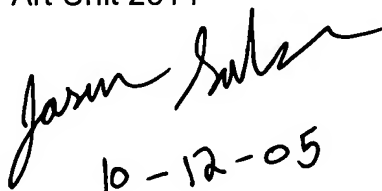
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason P Salce
Patent Examiner
Art Unit 2614

October 12, 2005


10-12-05